



PATENT
Customer No. 22,852
Attorney Docket No. 7707.0024-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Curtis LONGO) Group Art Unit: 3726
)
Application No.: 10/623,551) Examiner: Mazzuca, Jr., Douglas
)
Filed: July 22, 2003)
) Confirmation No.: 6032
For: VIBRATION APPARATUS AND)
METHODS OF VIBRATION)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated December 2, 2005, the Examiner required
restriction under 35 U.S.C. § 121 between the following three species:

Species A: Claims 1-14 as allegedly drawn to a method, apparatus, and system
of vibrating a tooling;

Species B: Claims 15-22 as allegedly drawn to a method and system of filling a
tooling; and

Species C: Claims 23-29 as allegedly drawn to a method and system of
extracting from a tooling.

The Examiner also asserted that Species A was generic, and that if Applicant
elected Species A, applicant must also elect one of the following subspecies:

Subspecies D: Claims 1-5 and 9-14 as allegedly drawn to a method and apparatus for vibrating; and

Subspecies E: Claims 6-8 as allegedly drawn to a tooling for a fuselage.

For the reasons set forth below, Applicants respectfully traverse the Examiner's restriction requirement.

First, the Examiner concludes that Species A, B, and C are "patentably distinct." The Examiner, however, has not provided any basis for this conclusion. The MPEP requires that:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP § 808.01. Because the Examiner has provided only a conclusion as to the alleged distinctness and has not provided any reasons for this conclusion, the restriction requirement is improper. Moreover, Applicant cannot properly respond to the Examiner's restriction requirement absent an explanation as to why the Examiner believes the species are patentably distinct.

Second, Species A-C are not patentably distinct because the application discloses a relationship between the inventions of the claims. MPEP § 806.06. Specifically, the inventions of the claims all relate to vibration apparatus or methods of vibration for tooling. In restricting species claims, the MPEP requires that:

Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

MPEP § 808.01(a). The Examiner, however, has not discussed this relationship or the reasons why this disclosed relationship does not prevent restriction.

Moreover, for a restriction requirement, there must be a serious burden on the Examiner to examine the claims in one application in order for restriction to be appropriate. MPEP § 803. In order to establish that a serious burden exists, the Examiner must demonstrate (a) separate classification; (b) separate status in the art; or (c) a different field of search. MPEP § 808.02 In the restriction requirement, however, the Examiner has not demonstrated any of these requirements, and thus, has not established a significant burden. Therefore, for these reasons, Applicant respectfully requests that the Examiner withdraw the restriction requirement between Species A-C. Alternatively, Applicant requests that the Examiner provide the basis for restriction so that it may have the opportunity to respond.

Even if the Examiner finds restriction between Species A-C appropriate, the Examiner has not established that restriction between Subspecies D and E is also appropriate. The Examiner is required to provide specific reasons for restriction and demonstrate a serious burden on the Examiner to examine the claims in one application. MPEP §§ 803, 808.01. The Examiner, however, has neither provided any reason for restriction nor demonstrated any serious burden in examining these claims together. Therefore, Applicant respectfully requests that the Examiner also withdraw this restriction requirement between Subspecies D-E.

Should the Examiner continue to assert that these restrictions are proper, Applicants provisionally elect to prosecute Species A, Subspecies D, claims 1-5 and 9-14.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 29, 2005

By: 

D. Brian Kacedon
Reg. No. 46,814